Supreme Court, U.S.
FILED
NOV 18 1999
CLERK

No. 99-150

IN THE
Supreme Court of the United States

WAL-MART STORES, INC.,
Petitioner,

v.

SAMARA BROTHERS, INC.,
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF FOR *AMICUS CURIAE* AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF NEITHER PARTY

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November 18, 1999

QUESTION PRESENTED

What must be shown to establish that a product's design is inherently distinctive for purposes of Lanham Act trade-dress protection?

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INTEREST OF THE AMICUS CURIAE[1]

The American Intellectual Property Law Association ("AIPLA") is a national association of approximately 10,000 attorneys with interests and practices primarily in the areas of trademark, patent, copyright, trade secret and other intellectual property law. AIPLA attorneys are employed by private law firms, corporations, universities, and governments, and represent creators, owners and users of intellectual property. Unlike areas of practice in which separate and distinct plaintiffs' and defendants' bars exist, most intellectual property law attorneys represent both intellectual property owners and alleged infringers.

The AIPLA has no stake in the parties to this litigation or the result in this case. It takes no position in favor of either petitioner or respondent. AIPLA does, however, have a substantial interest in clarifying the criteria for determining whether product designs are inherently distinctive and thus qualify for trade dress protection under the Lanham Act. At present, several of the federal circuit courts of appeals employ different criteria for this determination. A uniform and workable standard for inherently distinctive product

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[1] Pursuant to Rule 37.6, the *amicus curiae* states that this brief was not authored, in whole or in part, by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the *amicus curiae* or its counsel.

Pursuant to Rule 37.3, the parties have consented to the filing of this brief. Their letters of consent accompany this brief.

design trade dress will yield fairer, more predictable results in disputes involving intellectual property. Such a standard will help prevent forum shopping and opportunistic litigation, will enable individuals, companies and their attorneys to better assess the protectability of product designs, and will facilitate investment in proprietary brand identification, thus promoting fair competition.

SUMMARY OF THE ARGUMENT

This case affords the Court an opportunity to specify the criteria that should be considered in determining whether a product design is inherently distinctive and thus protected under Section 43(a) of the Lanham Act.[2] In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Court applied traditional trademark principles and statutory construction to hold that non-functional, inherently distinctive trade dress is protectable without the necessity of showing secondary meaning. 505 U.S. 763, *reh'g denied*, 505 U.S. 1244 (1992). Three years later, in *Qualitex Co. v. Jacobson Prods. Co., Inc.*, the Court again applied such principles and construction to affirm that color alone may be protected under the Lanham Act when it serves to identify the source of goods. 514 U.S. 159 (1995).

Since then, the courts of appeals have articulated numerous tests and factors for determining whether a product's design is inherently distinctive and protected under Section 43(a) of the Lanham Act. In some cases, these

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2/ A decision as to the criteria applicable to Section 43(a) also will be useful in evaluating unfair competition claims arising under the common law, since Section 43(a) establishes a federal statutory cause of action analogous to the common law tort of unfair competition.

differing criteria employed by the circuits reflect a fundamental disagreement over whether it is conceptually possible or appropriate to apply the analysis used for word trademarks to product designs, and whether a different, perhaps stricter, test is necessary to achieve the policy goals of the Lanham Act and to promote competition.

The Court should establish the standard for determining when product design features are inherently distinctive under the Lanham Act. The standard must be consistent with the goals of the Act, to "secure to the owner of the mark the goodwill of its business and to protect the ability of consumers to distinguish among competing producers." *Two Pesos*, 505 U.S. at 774 (quoting S. Rep. No. 79-133 at 3-5 (1946) from *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)). The standard should also make it possible to distinguish between designs that are intrinsically capable of identifying a product's source and those which may acquire distinctiveness only through use (i.e., acquire "secondary meaning").

Ultimately, the essential issue in determining protectability of trade dress is "whether or not the trade dress is of such a design that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers." *Insty*Bit Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 672-73 (8th Cir. 1996), *reh'g, en banc, denied*, 1996 U.S. App. LEXIS 27365 (8th Cir. Oct. 21, 1996), *cert. denied*, 519 U.S. 1151 (1997). To determine this, AIPLA urges the Court to adopt a standard which considers the following: (1) whether the design is a common basic shape or design; (2) whether the design is unique or unusual in a particular field; (3) whether the design is a mere refinement of a commonly-adopted and well-known form of

ornamentation for a particular class of goods, viewed by the public as a dress or ornamentation for the goods; (4) whether the design is capable of creating a commercial impression distinct from the accompanying words, if any; and (5) any other factors or evidence which may tend to show that the design for which protection is sought would be recognized by members of the relevant public as an indication of source, origin, sponsorship, affiliation, or approval.[3] The factors identified in this test are probative of inherent distinctiveness, but should not be viewed as necessary and independent criteria which must all be satisfied by every inherently distinctive design. AIPLA believes these factors can be readily understood and applied, and that resulting judgments would be consistent with the goals of the Lanham Act. Such a test also would provide courts the flexibility to consider factors that would be relevant in a particular situation but that may not be appropriate in others.

3/ The first four factors are derived from the *Seabrook* test, which has been adopted in the First and Federal Circuits and discussed in the Second and Fourth Circuits in connection with product design trade dress. See *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977). The fifth factor is intended to allow courts the flexibility to consider other relevant facts that may not easily be categorized under the first four factors.

ARGUMENT

A. Product design trade dress can be inherently distinctive.

The protection against unfair competition available under Section 43(a) of the Lanham Act[4] extends to product designs.[5] The purpose of the Lanham Act is to "provid[e] national protection of trademarks in order for owners of marks to secure the goodwill of their businesses and in order to protect the ability of consumers to distinguish among competing producers." *Sunrise Jewelry Mfr. Corp. v. Fred S.A.*, 175 F.3d 1322, 1325 (Fed. Cir. 1999) (citing S. Rep.

4/ Lanham Act Section 43(a)(1) establishes a cause of action against unfair competition based on the alleged infringer's use "on or in connection with any goods or services, or any container for goods . . . [of] any word, term, name, symbol, or device, or any combination thereof . . . which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services or commercial activities by another person. . . ." 15 U.S.C. § 1125(a)(1) (1994).

5/ *See, e.g., Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 199 (S.D.N.Y. 1999) (quoting 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 8.5 at 8-14 (4th ed. 1996): "The definition of trade dress has now been 'stretched to include the shape and design of the product itself'"), *aff'd*, 191 F.3d 208 (2d Cir. 1999); *Duraco Prods., Inc. v. Joy Plastics Enters., Ltd.*, 40 F.3d 1431, 1438-39 (3d Cir. 1994).

No. 79-1333 at 3, 5 (1946)). In *Two Pesos v. Taco Cabana*, the Court found that nothing in the statute provides a basis for "treating . . . verbal or symbolic trademarks differently from . . . trade dress." 505 U.S. 763, 774 (1992). Trade dress is "the total image of a product, and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." 505 U.S. at 764 n.1 (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)); *See also Duraco*, 40 F.3d at 1438-39. The Court has specifically held that color, used as a feature of product designs or trade dress, may function as a trademark, so long as it "act[s] as a symbol that distinguishes a firm's goods and identifies their source, without serving any other significant function." *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995). "It is the source-distinguishing ability of the mark - not its ontological status as color, shape, fragrance, word, or sign - that permits it to serve these basic purposes." 514 U.S. at 164. This reasoning also applies with respect to other aspects of product design trade dress.

In *Two Pesos*, the Court stated the general rule that, for protection under Section 43(a) of the Lanham Act, trade dress must be non-functional and either be inherently distinctive or have acquired distinctiveness through secondary meaning. 505 U.S. at 769. Trade dress is "distinctive" and entitled to protection when it is "capable of identifying products or services as coming from a specific source." 505 U.S. at 773. *Inherently* distinctive trade dress is trade dress that serves to identify a particular source of a product "because [of its] intrinsic nature." 505 U.S. at 768. Proof that the public identifies an inherently distinctive product design or trade dress with a single source is unnecessary. Where other requirements are met, inherently

distinctive trade dress is presumed to identify the source of the goods or services, and is entitled to protection under Section 43(a). *Cf.* 505 U.S. at 773.

The producer of a product whose design is inherently distinctive may, under Section 43(a), prevent competitors from using a confusingly similar design from the moment the inherently distinctive product appears on the market. Because secondary meaning or acquired distinctiveness can be difficult and costly to prove, the ability to assert rights in a product design without such proof is valuable, and is especially critical to new market entrants. *See* 505 U.S. at 775.

B. Uncertainty over the standard for determining whether a product design is inherently distinctive undermines the purposes of the Lanham Act.

Trademarks and trade dress play a major role in reducing consumer costs and in creating an incentive for the production of quality goods. *See, e.g., Qualitex*, 514 U.S. at 163-64 and citations therein. These benefits, however, are substantially undermined by the current uncertainty over the standard for determining whether a particular design is inherently distinctive and thus presumed to identify the product's source. *Cf. Two Pesos*, 505 U.S. at 774 ("Engrafting onto § 43(a) a requirement of secondary meaning for inherently distinctive trade dress also would undermine the purpose of the Lanham Act.")

This issue was not before the Court in either *Two Pesos* or *Qualitex*. Since then, the Circuits that have addressed the issue have characterized an inherently distinctive product design as one which: "is capable of functioning as a

designator of an individual source of the product," *Ashley Furniture, Inc. v. San Giacomo N.A. Ltd.*, 187 F.3d 363, 366 (4th Cir. 1999); "is likely to be understood as an indicator of the product's source," *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 378 (2d Cir. 1997); "is likely to serve primarily as a designator of origin of the product," *Duraco*, 40 F.3d at 1449, *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008 (2d Cir. 1995); "almost automatically tell[s] a customer that [it] refer[s] to a brand;" *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1502 (10th Cir. 1995), *cert. denied*, 516 U.S. 1067 (1996); and one which "a buyer will immediately rely on . . . to differentiate the product from those of competing manufacturers." *Insty*Bit, Inc.*, 95 F.3d at 673 (quoting *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1206 (Fed. Cir. 1994)). The courts of appeals have considered a variety of factors and utilized different tests in determining whether a particular design is presumptively source-identifying.

The First Circuit has expressly adopted the Court of Customs and Patent Appeals' *Seabrook* test to determine whether product design is inherently distinctive. *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 40 (1st Cir. 1988) (citing *Wiley v. American Greetings Corp.*, 762 F.2d 139 (1st Cir. 1985)). The Second Circuit has found the *Seabrook* factors to be consistent with its test, *Landscape Forms*, 113 F.3d at 378, and the Fourth Circuit relies on the *Seabrook* factors to clarify the distinctions required in its own analysis, *Ashley Furniture*, 187 F.3d at 371. The *Seabrook* test asks: (1) whether the design is a "common" basic shape or design; (2) whether the design is unique or unusual in a particular field; (3) whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods, viewed by the public as a dress or

ornamentation for the goods; or (4) whether it is capable of creating a commercial impression distinct from the accompanying words." *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). AIPLA believes that this test, coupled with an additional instruction to consider any other factors or evidence tending to show that particular product design trade dress would be recognized by members of the relevant public as an indicator of source, origin, sponsorship, affiliation or approval, is the test most likely to result in the fair and correct adjudication of disputes involving product design trade dress.

The Fourth, Fifth and Eighth Circuits apply the same analysis for determining distinctiveness regardless of whether the intellectual property that is being evaluated is a trademark, package design, or product design. *Ashley Furniture*, 187 F.3d at 369-70; *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998), *reh'g denied*, 1998 U.S. App. LEXIS 29648 (5th Cir. Oct. 26, 1998); *Insty*Bit*, 95 F.3d at 672; *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 785 (8th Cir. 1995). Often citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976), these Circuits consider "whether, and how much, the trade dress is dictated by the nature of the product." *Stuart Hall*, 51 F.3d at 785-86. Thus, "generic" trade dress is incapable of functioning primarily as a source indicator, "descriptive" trade dress can function as a source indicator only if it has acquired secondary meaning, and trade dress that is "suggestive", "arbitrary" or "fanciful" qualifies for protection under Section 43(a) without a showing of secondary meaning.[6] While this test may be helpful in some instances,

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[6] *See, e.g., Ashley Furniture*, 187 F.3d at 369-70. In explaining how these categories apply to product design, the

it is difficult to communicate to a judge or jury what might be "generic", "descriptive", or "suggestive" with respect to a particular product design.

In evaluating product design trade dress, the Second Circuit asks "whether the design [is] likely to be understood as an indicator of a product's source." *Landscape Forms*, 113 F.3d at 378. Factors the Second Circuit has considered in determining inherent distinctiveness of product designs include: whether the creators intend the design to function as a source indicator (i.e., rather than to serve aesthetic or other purposes), *see, e.g., Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, 165 F.3d 120, 125 (2d Cir. 1998), *cert. granted, in part*, 1996 U.S. LEXIS 6583 (Oct. 4, 1999); whether the elements of the claimed trade dress are articulated with enough specificity to determine whether they are, as a whole, functional, *see, e.g., Landscape Forms*, 113 F.3d at 377; and whether protection is sought for an entire line of products, where the "concern for protecting competition is especially acute." *Id.* at 388 (quoting *Jeffrey Milstein v. Gregor, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (2d Cir. 1995)). As characterized by the Southern District of New York, the Second Circuit's "standard for determining the inherent

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Fourth Circuit provides the example of banana-flavored candy, which "would be generic if the candy were round, descriptive if it were shaped like a banana, suggestive if it were shaped like a monkey, arbitrary if it were shaped like a trombone, and fanciful if it were formed into some hitherto unknown shape." 187 F.3d at 370. The Fifth Circuit defines descriptive trade dress as trade dress which "identifies a characteristic or quality of an article or service, such as its color, odor, function, dimensions, or ingredients." *Pebble Beach*, 155 F.3d at 540.

distinctiveness of a product's design is more rigorous than that for determining the inherent distinctiveness of the product's packaging," *Nabisco*, 50 F. Supp. 2d at 199 (citing *Knitwaves*, 71 F.3d at 1007-08). The Second Circuit thus holds that a different, stricter test is necessary to achieve the policy goals of the Lanham Act and to protect competition. *Landscape Forms*, 113 F.3d at 379-80.

The Third Circuit has likewise applied a stricter standard to product design trade dress. That Court focuses on likely public perception of the product's design as a source-indicator and the impact that protection under Section 43(a) is likely to have on competitors. It has held that, without proof of secondary meaning, Lanham Act protection for product design features should be available only under very limited circumstances. It reasons that a design feature is inherently distinctive only where

> there is a high probability that [it] serves a virtually exclusively identifying function for consumers – where the concerns over 'theft' of an identifying feature or combination or arrangement of features and the cost to an enterprise of gaining and proving secondary meaning outweigh concerns over inhibiting competition, and where consumers are especially likely to perceive a connection between the product's configuration and its source.

Duraco, 40 F.3d at 1434. Under the Third Circuit's test, an inherently distinctive product design must be (1) unusual and memorable; (2) conceptually separable from the product; and (3) likely to serve primarily as a designator of origin of the product. *Id.* at 1434, 1449-50.

Other circuits have criticized *Duraco* for imposing a standard for product design trade dress that appears to go beyond what this Court intended in *Two Pesos*. *See, e.g.*, *Stuart Hall*, 51 F.3d at 787-88; *Ashley Furniture*, 187 F.3d at 370-72. The stricter standards for inherent distinctiveness imposed by the Second and Third Circuits are unnecessary and, in fact, may lead to incorrect results. For instance, whether a design feature is "conceptually separable from the product itself," as required by *Duraco*, 40 F.3d at 1449, is more relevant to the question of whether the design is somehow functional than to its distinctiveness.[7]

In some cases, the different tests noted above reflect a fundamental disagreement over whether it is conceptually possible or appropriate to apply the same analysis to product design trade dress that is applied to word trademarks or packaging trade dress. The call by some for a stricter standard for product designs appears to stem, at least in part, from a failure to appreciate that protectable trade dress must be both non-functional and distinctive. For instance, the Third Circuit in *Duraco* appears to hold that, because product designs are, in a vast majority of instances, related to either the utilitarian functionality or the aesthetic appeal of the product, a very strict standard is required for such a design to achieve the coveted status of inherent distinctiveness, and that such a status can be achieved only rarely. *Duraco*, 40 F.3d at 1441-48. Even the Fifth Circuit,

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[7] Indeed, the requirement that a design must be physically or at least conceptually separable from the utilitarian features of an article in order to qualify for protection seems to be borrowed from copyright law. *See, e.g., Brandir Int'l, Inc. v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1143-44 (2d Cir. 1987).

which applies the *Abercrombie* categories to identify inherently distinctive product designs, misconstrues the Court's distinction between the non-functionality and distinctiveness requirements set forth in *Two Pesos*. *Cf. Pebble Beach*, 155 F.3d at 536 (citing *Two Pesos*, 505 U.S. at 775, as support for its statement of the rule that "trade dress is not protectable and cannot be distinctive if it is functional").

Unfortunately, the application of such different standards means that a product design considered inherently distinctive in one circuit may not be deemed inherently distinctive in another. The inevitable consequence is forum shopping by those seeking to assert or defend against a trade dress infringement claim, and inequitable application of the presumptions and protection available under the Lanham Act. This undermines the intent of Congress to create nationally uniform protections for trademarks and trade dress. Furthermore, a standard that sets the bar too high or too low can have an anti-competitive effect. Too high a standard withholds the financial benefits of the goodwill established by the owner of the trade dress and prevents consumers from readily distinguishing among competing producers. Too low a standard frustrates the legitimate interests of competitors in bringing their goods and services to the public.

C. The Court should establish a uniform standard based on objective, readily understood criteria for determining whether product designs are inherently distinctive.

As the Court has recognized, in order for trade dress to qualify for protection, it must not only have inherent or

acquired distinctiveness, it must also be non-functional. *Two Pesos*, 505 U.S. at 769. The non-functionality requirement "prevents trademark law . . . from . . . inhibiting legitimate competition by allowing a producer to control a useful product feature." *Qualitex*, 514 U.S. at 164, 169-70. This requirement is a separate element in the two-part test established by the Court for determining whether a particular trade dress is eligible for protection under the Lanham Act, and requires a separate analysis.[8] The analysis required to assure that trade dress is non-functional thus acts in tandem with the analysis of distinctiveness, and helps assure that Lanham Act protection will not be extended to trade dress that is undeserving of such protection. *See Ashley Furniture*, 187 F.3d at 375.

The essential characteristic of inherently distinctive trade dress is that its design is "such . . . that a buyer will immediately rely on it to differentiate the product from those of competing manufacturers." *Insty*Bit*, 95 F.3d at 673. The issue of inherent distinctiveness concerns the "intrinsic nature" of the specific product features for which rights are being asserted. Therefore, the test for inherent distinctiveness should be an objective one, based on a

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[8] The Court already has recognized the possibility that a distinctive, source-identifying product design may nonetheless be ineligible for protection under Section 43(a) because it is functional. In *Qualitex*, the Court offered the example of a special, illumination-enhancing shape for a light-bulb, that might be identified with a particular manufacturer, but would not be protected under the Lanham Act because to do so would "frustrat[e] competitors' legitimate efforts to produce an equivalent illumination-enhancing bulb." 514 U.S. at 165.

dispassionate evaluation of the design in question, not speculation.

AIPLA believes that the factors identified by the Court of Customs and Patent Appeals in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.* provide the appropriate starting point for any analysis of the inherent distinctiveness of a product's design. *See* 568 F.2d at 1344. These factors are: (1) whether the design is a common basic shape or design; (2) whether the design is unique or unusual in a particular field; (3) whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods, viewed by the public as a dress or ornamentation for the goods; or (4) whether it is capable of creating a commercial impression distinct from the accompanying words. The *Seabrook* factors are readily understandable and can be applied objectively to assess the intrinsic nature of designs. The first three factors compare the design for which Lanham Act protection is claimed with designs used by other manufacturers for similar products. *See Stuart Hall*, 51 F.3d at 786-87. The final *Seabrook* factor asks the fact-finder to distinguish between the graphic and verbal elements in the claimed design. None of the factors in this test requires speculation about whether and to what degree the public actually identifies the particular design features with a single source.[9] Rather, they provide an objective standard for

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[9] Although the third factor refers to the public's view of the design as ornamentation, the relevant concern is whether it is a refinement of a commonly-adopted and well-known form of ornamentation. This differs from the *Duraco* and *Knitwaves* tests, discussed *supra*, in that it does not require a positive finding, based on speculation, that the design is viewed as source-identifying, but only that it would

assessing "'whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin -- a trademark.'" *I.P. Lund*, 163 F.3d at 40 (quoting McCarthy, *supra* note 9, § 8.13). These factors, therefore, avoid the unintentional "engrafting onto Section 43(a) a requirement of secondary meaning for inherently distinctive trade dress." *Two Pesos*, 505 U.S. at 774.

The standard established by this Court should also permit the lower courts flexibility to consider other factors which may tend to show that the design for which protection is sought would be recognized by members of the relevant public as an indication of source, origin, sponsorship, affiliation or approval. Thus, for instance, while proof of secondary meaning is not required to show that a design is inherently distinctive, evidence that the public or the media immediately identifies the design with a particular manufacturer may be relevant in proving inherent distinctiveness. Consideration of such additional factors should not be precluded where it would assist the judge or jury to assess the inherent distinctiveness of a product's design. Accordingly, the following additional consideration should be added to the four *Seabrook* factors to provide the flexibility courts need in assessing inherent distinctiveness of product design trade dress: any other factors or evidence which may tend to show that the design for which protection is sought would be recognized by members of the relevant public as an indication of source, origin, sponsorship, affiliation, or approval.

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not be viewed as "mere ornamentation."

CONCLUSION

For the foregoing reasons, AIPLA urges the Court to establish a standard for determining whether product designs are inherently distinctive. The standard should include the four *Seabrook* factors. In addition, the Court should direct the lower courts to consider any other factors or evidence tending to show that particular product design trade dress would be recognized by members of the relevant public as an indication of source, origin, sponsorship, affiliation, or approval.

Respectfully submitted,

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November 18, 1999